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No. 05-1583

In the Supreme Court of the United States

IMPAX LABORATORIES, INC.,

Petitioner,

v.

ASTRAZENECA AB, AKTIEBOLAGET HASSLE, KBI-E, INC., KBI, INC. AND ASTRAZENECA LP,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF IN OPPOSITION

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Pursuant to Rule 29.6, Respondents state that the parent corporations or publicly held companies holding 10% or more of the stock of AstraZeneca AB, Aktiebolaget Hassle or AstraZeneca LP are AstraZeneca PLC and Zeneca Wilmington, Inc. and that the parent corporation or publicly held company holding 10% or more of the stock of KBI-E, Inc. and KBI, Inc. is Merck & Co., Inc.

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INTRODUCTION

The Court of Appeals decided this case by employing a straightforward application of its recent holding in *In re Technology Licensing Corp.*, 423 F.3d 1286 (Fed. Cir. 2005), *cert. denied*, ___ U.S. ___ (June 5, 2006). *Technology Licensing* held that a party seeking a declaratory judgment of patent invalidity has no right to a jury trial where in the underlying controversy the patentee seeks only equitable remedies.

The Court denied Technology Licensing Corporation's petition for *certiorari* earlier this Term. The Petitioner here concedes that the Technology Licensing petition raised the same issue presented in this case. The present petition should likewise be denied.

The Federal Circuit in *Technology Licensing* followed this Court's Seventh Amendment precedent, under which the nature of the relief sought is given special weight in the otherwise "abstruse historical" inquiry into whether a jury right would exist had the case been brought in the 18th Century English courts. *Tull v. United States*, 481 U.S. 412, 417 (1987). That analysis was performed correctly in *Technology Licensing* and applied consistently in this case.

The rule of *Technology Licensing* creates no circuit conflicts in light of the Federal Circuit's exclusive jurisdiction over patent infringement litigation. Furthermore, and contrary to Petitioner's assertions, that decision is clear and understandable to district courts hearing patent cases (as demonstrated by the district court's application of it here) and is harmonious with more than a decade of previous Federal Circuit precedent on the issue.

In fact, this case presents even stronger reasons for denial because its procedural posture makes it an extremely poor

In January 2005, after learning that Teva Pharmaceuticals USA, Inc. had started commercial sales of Petitioner's 10mg and 20mg omeprazole product under a strategic alliance agreement with Petitioner, Respondents filed a second amended complaint requesting, in addition to the previously sought equitable relief, an award of money damages under 35 U.S.C. §284 pursuant to 35 U.S.C. §§271(a)–(c). PMApp. at A156-165. Respondents also filed a separate action against Teva. PMApp. at A354-362. In response, Petitioner answered and re-asserted its invalidity and unenforceability counterclaims and its previously stayed antitrust claims. In addition, Petitioner for the first time made a general jury demand. PMApp. at A166-219.

Petitioner is one of four groups of defendants (known as the "Second Wave" defendants) who are accused of infringing the same patents by applying for FDA approval to market generic omeprazole. These cases were consolidated in the United States District Court for the Southern District of New York before the Hon. Barbara S. Jones for pre-trial proceedings by the Judicial Panel on Multidistrict Litigation, and have been consolidated for trial in that district. *In re Omeprazole Patent Litigation*, MDL Docket No. 1291. Judge Jones previously conducted a consolidated bench trial of four "First Wave" defendants in 2002 involving the same patents. *See In re Omeprazole Patent Litigation*, 222 F.Supp.2d 423 (S.D.N.Y. 2002), *aff'd*, 84 Fed. Appx. 76 (Fed. Cir. 2003).

By December 2005, it became clear that Petitioner would assert that, in light of its jury demand it could not be part of a contemplated consolidated bench trial of other Second Wave defendants on patent liability issues then scheduled for early 2006. PMApp. at A460-462. Respondents thereafter obtained the district court's permission to voluntarily waive their claims for damages against Petitioner with prejudice,

leaving in place only Respondents' claims for equitable relief. Pet. App. 38a-45a; PMApp. at A11-12. Relying on *Technology Licensing*, the district court struck Petitioner's jury demand. *See* Pet. App. at 43a. The district court continued thereafter with pre-trial proceedings leading to a consolidated bench trial of the Second Wave defendants, including Petitioner.

Shortly before trial, Petitioner sought reconsideration of the district court's decision striking its jury demand. The district court denied reconsideration and expanded on its explanation of its application of *Technology Licensing*. *See* Pet. App. at 15a-21a. Petitioner thereafter unsuccessfully sought a writ of mandamus and subsequent rehearing and rehearing *en banc* from the Federal Circuit. Pet. App. 1a-7a. Each of the district court and Court of Appeals decisions below relied fundamentally on the holding in *Technology Licensing* that a party seeking a declaratory judgment of patent invalidity has no right to a jury trial where in the underlying controversy the patentee seeks only equitable remedies. *See* Pet App. at 6a-7a, 15a-21a, 43a.

The consolidated bench trial of the Second Wave defendants, including Petitioner, commenced on April 3, 2006 and the evidentiary record was closed on June 15, 2006. The parties anticipate completing post-trial briefing on July 28, 2006 and expect that the district court will issue its findings of fact and conclusions of law under FED. R. CIV. P. 52(a) in due course.

REASONS FOR DENYING THE WRIT

The Federal Circuit in *Technology Licensing* applied this Court's "historical test" for determining whether the Seventh Amendment guarantees a jury trial to a party seeking a declaratory judgment of patent invalidity where the patentee

seeks only equitable relief in the underlying controversy. The court held that the declaratory judgment claimant did not have a right to a jury trial in those circumstances. The district court and the Federal Circuit both applied the same rule in this case. *See* Pet. App. at 7a ("We agree that our decision in *Technology Licensing* supports the district court's determination that Impax was not entitled to a jury trial on its counterclaims regarding the patents.").

Although the decision in *Technology Licensing* drew the dissent of one judge, the Federal Circuit declined invitations to revisit the issue *en banc* both in *Technology Licensing* and in this case. This Court denied *certiorari* in *Technology Licensing* just last month. No reason exists for the Court to disturb in this case what has evolved as an orderly and consistent application by the Federal Circuit of a manifestly correct constitutional rule.

A. The Court Already Concluded Earlier in This Term That the Question Presented Does not Merit Review.

On June 5, 2006, the Court denied *certiorari* in *Technology Licensing*. The petition in that case cast the question presented as: "Whether the Seventh Amendment right to jury trial of the parties to a declaratory relief action for patent invalidity should be governed solely by the nature of the remedy sought in the patentee's claim or counterclaim for infringement." *See* Pet. for *Certiorari* in *Technology Licensing Corp. v. Gennum Corp.*, No. 05-1248 (filed Mar. 28, 2006). The petition asserted that this Court should intervene because the Federal Circuit's precedent was unclear and in conflict with this Court's Seventh Amendment precedent. *Id.* at 11-24.

Petitioner in this case states that "Technology Licensing Corporation's petition presents the same question as the present case" and requests that the Court consider the two petitions together. *See* Pet. at 2. The current petition makes essentially the same arguments that were rejected in Technology Licensing Corporation's petition. For the reasons explained below, the Court's decision not to review this issue in *Technology Licensing* was correct. The current petition should also be denied.

B. The Federal Circuit's Seventh Amendment Precedent is Neither Inconsistent nor Confusing.

As discussed in detail, *infra*, the Federal Circuit has for more than a decade consistently and correctly applied the rule that a right to a jury in a declaratory judgment action for patent invalidity depends on the relief sought by the patentee in the underlying infringement controversy that gives rise to declaratory judgment jurisdiction. There is nothing inconsistent or confusing about the way in which the Federal Circuit has applied its precedent in this area, which uniquely impacts patent disputes within the confines of that court's exclusive jurisdiction.

1. No Circuit Split is Possible in Light of the Federal Circuit's Exclusive Jurisdiction Over Patent Litigation.

Although the question presented in the petition is a constitutional one, it can arise only in a federal patent case over which the Federal Circuit is given exclusive jurisdiction. *See* 28 U.S.C. §1295(a)(1). Since passage of the Federal Courts Improvement Act of 1982, 96 Stat. 25, no other Court of Appeals has had jurisdiction to review declaratory judgments relating to patent validity, which in nearly every conceivable situation stem from cases or controversies

arising from assertions of patent infringement under 35 U.S.C. §271.

Inter-circuit conflict is therefore impossible. Petitioner nevertheless asserts conflict with cases from the First, Fifth and Sixth Circuits. *See* Pet. at 24-25. No such conflict exists, however. None of the cases cited by Petitioner involved declaratory judgment actions. Moreover, the rationale of all three decisions is identical to that in *Technology Licensing*—the nature of the relief sought governs whether a jury trial right exists.

In *Hildebrand v. Board of Trustees of Mich. State Univ.*, 607 F.2d 705, 708 (6th Cir. 1979), the Sixth Circuit held that "the chief focus to be made when determining whether a jury trial right exists is the nature of the relief sought." Because the relief sought in that case was legal—compensatory and punitive damages—the court held that the district court had erred by removing the case from the jury. In *In re Evangelist*, 760 F.2d 27 (1st Cir. 1985), the First Circuit decided, on mandamus, that the plaintiff's claim under the Investment Company Act of 1940 was equitable in nature, and therefore declined to order a jury trial. In *Armco, Inc. v. Armco Burglar Alarm Co., Inc.*, 693 F.2d 1155, 1158 (5th Cir. 1982), the Fifth Circuit held that after the plaintiff's claim for damages was dismissed, the defendant no longer had a right to a jury trial.

Thus, the three circuits allegedly in conflict with the Federal Circuit are not, in fact, in conflict. Each of these Courts of Appeal have looked to the nature of the relief sought by the claimant in order to determine whether a right to jury trial exists.

2. The Generalized "Confusion" Asserted in the Petition is Minimal and Does Not Merit Review.

Petitioner also asserts that the Federal Circuit's jurisprudence itself is "inconsistent" and "flawed." *See* Pet. at 16, 21-23. Tellingly, despite invitations to do so in both *Technology Licensing* and in this case, that court has not seen fit to consider the issue *en banc*, even in light of the dissenting opinion of one panel member in *Technology Licensing*. Petitioner's assertions lack merit.

Petitioner attempts to demonstrate its point by relying on two non-precedential decisions from the Federal Circuit (while ignoring the highly pertinent precedential decision in *Tegal Corp. v. Tokyo Electron America, Inc.*, 257 F.3d 1331 (Fed. Cir. 2001), discussed *infra*) and three district court cases (one of which is cited incorrectly). These cases, taken together, do not indicate that the law is unsettled. Moreover, all of these cases were decided before the Federal Circuit's clarifying and definitive opinion in *Technology Licensing*, which now obviates any claim of "confusion," regardless of whether any such claim ever had validity.

Petitioner's reliance on the Federal Circuit's non-precedential decisions in *In re SGS-Thomson Micro., Inc.*, 1995 WL 258370 (Fed. Cir.), *cert. denied*, 516 U.S. 931 (1995) and *In re Apotex*, 49 Fed. Appx. 902 (Fed. Cir. 2002) is particularly misplaced. Both decisions were issued under FED CIR. R. 47.6(b), which provides: "An opinion or order which is designated as not to be cited as precedent is one determined by the panel issuing it as not adding significantly to the body of law. Any opinion or order so designated must not be employed or cited as precedent." The Federal Circuit does not consider itself bound by its non-precedential opinions. *See Symbol Technologies, Inc. v. Lemelson*

Medical Educ. & Res. Found., 277 F.3d 1361, 1368 (Fed. Cir. 2002). A non-binding, non-precedential opinion *a fortiori* should not cause confusion or inconsistency in the Federal Circuit's jurisprudence.

Petitioner states nonetheless that three district courts have "interpreted *Lockwood* and "*SGS-Thompson* [sic]" to hold that a right to a jury trial exists on a counterclaim seeking a declaratory judgment of invalidity, without regard to whether the patentee could or did file a claim of damages in the same action." Pet. at 22. One of those decisions, *Sanofi-Synthelabo v. Apotex, Inc.*, 2002 WL 1917871 (S.D.N.Y. 2002), actually held to the contrary. *See id.* at *7 (striking jury demand of plaintiff who asserted claim only to equitable relief under 35 U.S.C. §271(e)(2)).

The remaining two cases cited by Petitioner were decisions of the District Court for the District of New Jersey in *Hoechst Marion Roussel, Inc. v. Par Pharmaceutical, Inc.*, 1996 WL 468593 (D.N.J. 1996) and *Warner-Lambert Co. v. Purepac Pharmaceutical Co.*, 2001 WL 883232 (D.N.J. 2001). The *Hoechst* decision was based on the mistaken view that the Federal Circuit's non-precedential decision in *SGS-Thomson* was "[t]he controlling law on this issue." 1996 WL 468593 at *5. That statement was inaccurate because, as explained above, *SGS-Thomson* was a non-precedential decision. The *Warner-Lambert* court, in turn, viewed the *Hoechst* decision as "clear authority" and also cited heavily to *SGS-Thomson*. 2001 WL 883232 at *2-*3.

The two New Jersey decisions were therefore based on the flawed premise that the Federal Circuit's non-precedential decisions were controlling. While a matter of concern, this does not rise to a level requiring this Court's intervention for the simple reason that now, the Federal Circuit has issued a precedential decision directly on point,

i.e., *Technology Licensing*. It therefore seems certain that the district court in New Jersey would apply *Technology Licensing* in any future case that raises the jury trial question, just as the district court and the Federal Circuit did in this case.

Moreover, the other district courts that have addressed the issue have applied the same rule applied in this case, even before the *Technology* Licensing decision was issued. The Northern District of Illinois held in *Glaxo Group Ltd. v. Apotex, Inc.*, 2001 WL 1246628 (N.D. Ill. 2001); *Pfizer, Inc. v. Novopharm Ltd.*, 2001 WL 477163 (N.D. Ill. 2001); and *Biovail Labs., Inc. v. Torpharm, Inc.*, 2002 WL 1732372 (N.D. Ill. 2002) that the relief sought by the patentee governed the course of trial. The District of Delaware also applied the same rule in a pre-*Technology Licensing* decision. *See KAO Corp. v. Unilever U.S., Inc.*, 2003 WL 1905635 (D. Del. 2003) (holding no right to jury existed after patentee withdrew its claims for damages). Petitioner's claims of "confusion" in the district courts over the question of when to grant a jury trial in patent declaratory judgment actions are therefore overblown.

The district court in this case, which benefited from the clear and unambiguous guidance pronounced in *Technology Licensing*, clearly suffered no confusion in holding that Petitioner was not entitled to a jury trial because Respondents had voluntarily abandoned their claim for damages. *See* Pet App. at 21a. No reason exists to suspect that district courts in the future will be confused by the Federal Circuit's clear guidance in *Technology Licensing* which was, as now discussed, manifestly correct.

C. *Technology Licensing* Correctly Held That the Nature of the Relief Sought by the Patentee Governs the Mode of Trial.

The Federal Circuit recognized in *Technology Licensing* that the right to a jury under the Seventh Amendment turns on this Court's two-part test: (1) a comparison of the action to the analogous action, if any, brought in 18th Century England; and (2) the nature of the relief sought. 423 F.3d at 1287; *Tull*, 487 U.S. at 417-18.

The Seventh Amendment preserves the right to a jury trial only in civil actions "at common law." U.S. CONST. AMEND. VII; *Chauffers, Teamsters & Helpers Local No. 391 v. Terry*, 494 U.S. 558, 564 (1990). An action "at common law" is one which would have been tried to a common law court, not a court of equity, in 18th Century England. *Tull*, 481 U.S. at 417 ("Prior to the [Seventh] Amendment's adoption, a jury trial was customary in suits brought in the English *law* courts. In contrast, those actions that are analogous to 18th-century cases tried in courts of equity or admiralty do not require a jury trial.") (emphasis in original).

This Court has called the determination of the correct 18th Century analog to a particular cause of action an "abstruse historical" exercise. *Id.* at 421. Thus, in characterizing a particular cause of action, the "relief sought is 'more important' than finding a precisely analogous common-law cause of action in determining whether the Seventh Amendment guarantees a jury trial." *Id.* (quoting *Curtis v. Loether*, 415 U.S. 189, 196 (1974)). *See also Granfinanciera S.A. v. Nordberg*, 492 U.S. 33, 42 (1989) ("The second stage of this analysis is more important than the first.").

"A key dividing line between law and equity has historically been that the former deals with money damages and the latter with injunctive relief." *Hildebrand*, 607 F.2d at 708. Historically, patentees sought "actual damages" in courts of law and equitable remedies (*e.g.*, injunctive relief or an accounting of infringer's profits) in courts of equity. *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1440 (Fed. Cir. 1998).

Prior to *Technology Licensing*, the Federal Circuit had addressed the question of whether the Seventh Amendment entitles a patent infringement defendant to a jury trial in two precedential decisions: *In re Lockwood*, 50 F.3d 966 (Fed. Cir.), *cert. granted*, 515 U.S. 1121, *vacated*, 515 U.S. 1182 (1995) and *Tegal Corp. v. Tokyo Electron America, Inc.*, 257 F.3d 1331 (Fed. Cir. 2001).

In *Lockwood*, the Federal Circuit held that a patentee who had sought money damages for infringement, but who had lost that claim in an interlocutory summary judgment, had a right to a jury trial of the patent defendant's declaratory judgment counterclaim for invalidity. In arriving at that conclusion, the Court of Appeals determined that the declaratory judgment claim for invalidity had no common law counterpart, but was most closely analogous to an inverted suit for patent infringement in which the affirmative defense of invalidity had been raised. 50 F.3d at 969-76. The patentee could direct the course of trial depending on his selection of the type of remedy he wished to pursue—in an action for damages at law, trial would be to a jury; in an equitable action seeking only injunctive relief, trial would be to the bench. *Id.* at 976.[2] In *Tegal*, the Federal Circuit held

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[2] This Court initially granted *certiorari*, 515 U.S. 1121 (1995). However, the Court later vacated the Federal Circuit's judgment and remanded the case to the district court for further proceedings

that a patent infringement defendant asserting the affirmative defense of invalidity was not entitled to a jury trial in a case where the patentee was seeking only equitable relief (*i.e.*, an injunction). 257 F.3d at 1339-41.

The facts presented by *Technology Licensing* differed from the prior cases in that, unlike in *Tegal*, the defendant had interposed a declaratory judgment claim for invalidity rather than an affirmative defense, and unlike *Lockwood*, it was the defendant, rather than the plaintiff, demanding a jury trial. *Technology Licensing*, 423 F.3d at 1288-90. The Federal Circuit held nonetheless that its reasoning in the two prior cases was dispositive. The court acknowledged its holding in *Lockwood* that a declaratory judgment for patent invalidity "resembles nothing so much as a suit for patent infringement in which the affirmative defense of invalidity has been pled." *Technology Licensing*, 423 F.3d at 1289 (quoting *Lockwood*, 50 F.3d at 974). In such suits, the Federal Circuit confirmed that it is the patentee who determines whether the right to jury trial exists:

> [I]n such common law actions, the patentee could elect whether to proceed at law or in equity, based on the remedy sought, and the right to a jury would depend on the patentee's choice:
>
> > If the patentee sought only damages, the patentee brought an action at law; in such a case, the defense of invalidity was tried to the jury, assuming that a jury had been demanded.... However, if the patentee facing past acts of infringement nevertheless sought

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after the patent owner withdrew his jury demand. 515 U.S. 1182 (1995). *See* Respondent's Motion to Dismiss as Moot in No. 94-1660, 1995 WL 848568.

> *only* to enjoin future acts of infringement, the patentee could only bring a suit in equity, and the defense of invalidity ordinarily would be tried to the bench.
>
> Thus, the [*Lockwood*] court concluded, under both English and American practice "it was the patentee who decided in the first instance whether a jury trial on the factual questions relating to validity would be compelled."

Technology Licensing, 423 F.3d at 1289 (quoting *Lockwood*, 50 F.3d at 976) (emphasis in original).

Applying the rule that the right to a jury trial is controlled by the relief sought by the patentee, the *Technology Licensing* court examined the distinction between the facts of its case and those of *Lockwood*. In *Lockwood*, the patentee had chosen to pursue a claim for damages but had lost that claim involuntarily as a result of an adverse ruling on summary judgment.[3] In *Technology Licensing* in contrast, the patentee had voluntarily and irrevocably dismissed its claim for damages and thus sought only injunctive relief. The *Technology Licensing* court found this distinction dispositive in ruling that no jury trial right existed in the case. This conclusion followed directly from the conclusion the court had drawn from its historical analysis: that the patentee decides the nature of the remedy being sought as the plaintiff in the inverted declaratory judgment action and thus controls the determination of whether the action is heard by a jury or the bench. *Technology Licensing*, 423 F.3d at 1289-90. The same result had been reached in *Tegal*, where the patentee

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[3] Even though Lockwood had lost his claim for damages on summary judgment, that was not a final decision and thus the damages claim could have been revived on a subsequent appeal.

had permanently withdrawn its claim for money damages only six days prior to trial and thus removed the right to a jury trial. *Tegal*, 257 F.3d at 1338.

This case, which is directly analogous to *Technology Licensing* in that the patentee has withdrawn its claim for damages, reached the same result. The Federal Circuit's jurisprudence has thus culminated in a clear rule that follows directly and logically from past precedent, and is simple to apply.

1. The Federal Circuit's Observation That The Nature of a Declaratory Judgment Action Derives Entirely From the Underlying Controversy That Creates it was Correct.

The Federal Circuit correctly determined in *Lockwood*, and confirmed a decade later in *Technology Licensing*, that an action for a declaratory judgment of patent invalidity, brought under 28 U.S.C. §§2201-02, has no close common law analog for purposes of this Court's Seventh Amendment "historical test." In 18th Century England, a party in apprehension of suit for patent infringement had no ability to initiate a private civil action to settle the controversy. The 20th Century declaratory judgment action in this country provided a new civil remedy that was not available to a party against whom a patent was asserted in 18th Century England.

Congress passed the Declaratory Judgment Act in 1934. 48 Stat. 955. Although the Act created a new statutory remedy, this Court initially described a declaratory judgment as "essentially an equitable cause of action." *Great Lakes Dredge & Dock Co. v. Huffman*, 319 U.S. 293, 300(1943)). Congress "explicitly contemplated that the courts would decide to grant or withhold declaratory relief on the basis of

traditional equitable principles." *Samuels v. Mackell*, 401 U.S. 66, 70 (1971).[4] This Court has more recently described declaratory judgment actions in the modern post-merger context as "neither legal nor equitable" and explained that they must be examined according to "to the kind of action that would have been brought had Congress not provided the declaratory judgment remedy." *Gulfstream Aerospace Corp. v. Mayacamas Corp.*, 485 U.S. 271, 284 (1988).

The Federal Circuit in *Lockwood* noted the *sui generis* nature of the declaratory judgment statute and concluded that because declaratory judgment jurisdiction derives entirely from the existence of an underlying controversy, such actions "are, for Seventh Amendment purposes, only as legal or equitable in nature as the controversies on which they are founded." *Lockwood*, 50 F.3d at 973 (citing *Gulfstream Aerospace*, *supra*). The Federal Circuit's conclusion follows directly from the observation that the jurisdiction of the federal courts to entertain declaratory judgment suits is

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[4] Creation of an alternative form of equitable relief to enable constitutional challenge to state laws was a paramount purpose of the Declaratory Judgment Act of 1934, which legislators at the time described as a "milder alternative" to the remedy of seeking a federal injunction under *Ex parte Young* against a state government official to prevent enforcement of a law being challenged. *See Steffel v. Thomson*, 415 U.S. 452, 466-67 (1974) (quoting S. Rep. No. 1005, 73d Cong., 2d Sess. (1934)). *See also* H.R. Rep. No. 1264, 73d Cong., 2d Sess., 2 (1934) ("The principle involved in this form of [declaratory judgment] procedure is to confer upon the courts the power to exercise in some instances preventive relief; a function now performed rather clumsily by our equitable proceedings and inadequately by the law courts.") (quoted in *Perez v. Ledesma*, 401 U.S. 82, 111-12 (1971) (BRENNAN, J., concurring in part)).

carefully circumscribed by Article III and by the Act itself. Federal courts may act under this jurisdiction only where there exists a "case of actual controversy." 28 U.S.C. §2201. The Act is "'operative only in respect to controversies which are such in the constitutional sense.'" *Textron Lycoming Reciprocating Engine Div. v. United Automobile, Aerospace and Agricultural Implement Workers of Am.*, 523 U.S. 653, 661 (1998) (quoting *Aetna Life Ins. Co. v. Haworth*, 300 U.S. 227, 239-240 (1937)).

To maintain a federal declaratory judgment suit, a plaintiff must demonstrate that a controversy exists that is immediate and real rather than abstract or distant. *Maryland Casualty Co. v. Pacific Coal & Oil Co.*, 312 U.S. 270, 273 (1941); *Evers v. Dwyer*, 358 U.S. 202, 203 (1958) (the "question in each case is whether the facts alleged [show a substantial controversy] of sufficient immediacy and reality to warrant the issuance of a declaratory judgment"). Thus, in patent cases, declaratory judgment jurisdiction is limited to controversies that are "actual, not hypothetical or of uncertain prospective occurrence," *BP Chems., Ltd. v. Union Carbide Corp.*, 4 F.3d 975, 977 (Fed. Cir. 1993), and where the dispute is of "sufficient immediacy and reality" to warrant judicial intervention. *Lang v. Pacific Marine & Supply Co.*, 895 F.2d 761, 765 (Fed. Cir. 1990).

Because declaratory judgment jurisdiction depends entirely on the existence of an actual controversy, it follows that the nature of the declaratory action derives from the nature of that controversy. This Court held in *Simler v. Conner*, 372 U.S. 221, 223 (1963), that the nature of the underlying dispute (an action on a contract) defined its "basic character" and thus gave rise to a jury trial even though it was brought in the form of a declaratory judgment action. *See id.* ("The fact that the action is in form a declaratory judgment case should not obscure the essentially legal nature

of the action."). The Federal Circuit's analysis in *Technology Licensing* is in full accord with this precedent.

The Federal Circuit's approach is also consistent with the approach taken by other Circuit Courts of Appeal that have analyzed the right to a jury trial in the context of declaratory judgment claims. *See, e.g., Shubin v. United States Dist. Court*, 313 F.2d 250, 251-52 (9th Cir. 1963) (holding no right to jury trial existed for declaratory judgment claim for patent invalidity where patentee had stipulated that no possibility of damages existed); *Petition of Rosenman & Colin*, 850 F.2d 57, 60 (2d Cir. 1988) ("the nature of the underlying dispute determines whether a jury trial is available"); *Owens-Illinois, Inc. v. Lake Shore Land Co.*, 610 F.2d 1185, 1189 (3d Cir. 1979) ("If the declaratory judgment action does not fit into one of the existing equitable patterns but is essentially an inverted law suit—an action brought by one who would have been a defendant at common law—then the parties have a right to a jury trial. But if the action is the counterpart of a suit in equity, there is no such right."); *Manning v. United States*, 146 F.3d 808, 811 (10th Cir. 1998) ("seeking declaratory relief does not entitle one to a jury trial where the right to a jury trial does not otherwise exist"); *James v. Pennsylvania General Ins. Co.*, 349 F.2d 228, 230 (D.C. Cir. 1965) ("The right to jury trial in a declaratory judgment action depends ... on whether the action is simply the counterpart of a suit in equity—that is, whether an action in equity could be maintained if declaratory judgment were unavailable—or whether the action is merely an inverted lawsuit.").

Petitioner argues from the flawed premise that a declaratory judgment claim for invalidity is wholly "independent" of the underlying claim for patent infringement. Petitioner cites for that proposition this Court's decision in *Cardinal Chemical Co. v. Morton Int'l,*

Inc., 508 U.S. 83, 96 (1993). *See* Pet. at 11. However, *Cardinal Chemical* held that a declaratory judgment claim for invalidity is "independent" of an infringement claim only in the context of deciding that a declaratory judgment claim for invalidity does not become moot on appeal after the appellate court has found no infringement. *Cardinal Chemical* does not speak to the nature of a declaratory judgment action insofar as it determines the existence *vel non* of the jury right, which is entirely distinct from the issue of whether an appellate finding of no infringement moots the appeal of the invalidity claim.

The Federal Circuit's determination in *Technology Licensing* that the jury trial right is determined by the relief sought by the patentee in the underlying controversy is thus logical and consistent with the precedent of this Court and the other Circuit Courts.

2. The 18th Century Writ of *Scire Facias* is not a Correct Analog to a Declaratory Judgment Action.

Despite the wealth of precedent to the contrary, Petitioner urges a different framework for analysis. It contends that an 18th Century common law analog to a declaratory judgment action for patent invalidity did exist in the form of the English writ of *scire facias*, and that such a finding compels the conclusion that a jury trial right exists in this case. *See* Pet. at 14-20. The Federal Circuit considered and correctly rejected this argument in both *Lockwood*, 50 F.3d at 974 n.9 and *Technology Licensing*, 423 F.3d at 1290; *see also id.* at 1292-96 (Newman, J., dissenting).

The writ of *scire facias* required the party against whom it issued to appear and show cause why a judicial record should not be enforced, repealed or annulled. *See* Am.

Heritage Dict. of the Engl. Language (4th ed. 2000). In 18th Century England, a King's subject could petition for a writ of *scire facias* to issue to the patentee to show cause why the patent should not be revoked where: (1) different patents had been issued to the same thing; (2) the patent had been granted by false suggestion; or (3) the patent had been granted contrary to law. *Mowry v. Whitney*, 81 U.S. 434, 440 (1871). In the first case, the writ could be issued in the name of the private party but in the latter cases, the writ issued only in the name of the King or his Attorney General. *Id.*; *United States v. American Bell Tel. Co.*, 128 U.S. 315, 360 (1888); *Attorney General v. Rumford Chem. Works*, 32 F. 608, 618 (C.C.D.R.I. 1876).

The *scire facias* was brought in the court of chancery. *Mowrey*, 81 U.S. at 440; *Rumford Chem. Works*, 32 F. at 618. The historical record indicates that where factual matters were disputed, the chancellor could refer those issues to a jury for trial. *See Rumford*, 32 F. at 618. However, jury proceedings in the chancery court were considered advisory, not a matter of right. *Cochrane v. Deener*, 94 U.S. 780, 783 (1876) ("A trial at law is ordered by a chancellor to inform his conscience, not because either party may demand it as a right, or that a court of equity is incompetent to judge questions of fact or of legal titles."). Moreover, nothing in the historical record indicates that the patentee, once served with the writ, could counterclaim for infringement and request relief in the same proceeding. The proceedings as reported appear to have focused exclusively on the grounds raised in the writ. This is an important difference from the modern-day declaratory judgment action, where an infringement counterclaim is permissible and may be compulsory.

If the writ of *scire facias* can be said to have an analog in modern day American practice, it is not a civil declaratory

judgment suit brought by a private individual for patent invalidity. Rather, if any such analog exists, it exists in the form of government-initiated proceedings to cancel an issued patent. This is apparent from a review of the methods historically available to challenge a patent in this country.

The first patent statutes in the United States differed from English law by granting a private right of action to repeal a patent within one year of issuance. *See* Act of April 10, 1790, §5, 1 Stat. 109, 111; Act of Feb. 21, 1793, §10, 1 Stat. 318. This Court described that right as "in the nature of a *scire facias*" and the matter was tried to a jury. *Ex parte Wood*, 22 U.S. 603, 610-11 (1824). However, when the patent statutes were re-written in 1836, that provision was repealed. As a result, beginning in 1836, "no one but the government, either in its own name or the name of its appropriate officer . . . [could] institute judicial proceedings for the purpose of vacating or rescinding the patent which the government has issued to an individual, except in [cases of interfering patents]." *Mowry*, 81 U.S. at 439.

Thus, in the 19th Century, this Court held that the Solicitor General could maintain a bill in equity to revoke two of Alexander Graham Bell's patents for alleged fraud. *United States v. Bell, supra.* Like the writ of *scire facias* in England, the case was brought in equity by the government and no provision existed for the patentee to bring counterclaims for infringement or otherwise obtain relief.

In modern times, a proceeding to cancel a patent (or claims thereof) takes the form of the statutory re-examination pursuant to 35 U.S.C. §§301-307 or 35 U.S.C. §§311-318. Re-examination proceedings are conducted by an examiner of the United States Patent & Trademark Office, the agency of the government responsible for the issuance of patents. Like the writ of *scire facias*, the proceeding begins with a

petition, normally from a third party, that raises detailed grounds for finding invalidity. If the agency chooses to initiate the proceeding, the patentee is called upon to respond, 35 U.S.C. §304, 314, and in certain instances the third party may comment on the proceedings. 35 U.S.C. §314(b)(2). However, the proceeding is not analogous to private civil litigation and no provision exists in the re-examination statute for patent infringement claims to be brought in the Patent & Trademark Office seeking either monetary or injunctive relief.

Even though the Patent Act of 1836 eliminated the private right of action to repeal a patent, a defendant in a patent infringement action could still raise invalidity defenses by "plead[ing] the general issue" including possible averments that the patentee had engaged in "concealment . . . for the purpose of deceiving the public" or that the patented invention was previously described in a public work, or in public use or on sale. *See* Act of July 4, 1836, §15, 5 Stat. 117, 123. Thus, beginning in 1836, invalidity was raised in private patent litigation solely as a defense against an infringement suit. The issue was neither inherently legal nor equitable and was not raised as a claim for relief at all.[5]

It was not until passage of the Declaratory Judgment Act of 1934 that an affirmative private cause of action for patent invalidity re-appeared in American jurisprudence. However, as discussed *supra*, the declaratory judgment action is a *sui generis* remedy that derives from the existence of a specific, immediate and concrete controversy that can be resolved by

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[5] In 18th Century England, invalidity was likewise available as a defense in a suit for infringement. *See, e.g., Boulton & Watt v. Bull*, 2 H.B. 463 (1795) (examining validity of Watt's steam engine patent in his infringement action against Bull).

the federal courts pursuant to the powers granted under Article III.

The modern declaratory judgment action is therefore entirely distinct from the writ of *scire facias*, both historically and procedurally. In England, *any* subject with a generalized claim of prejudice could petition the King to bring a *scire facias*. *Mowry*, 81 U.S. at 440 ("[W]hen a patent is granted to the prejudice of the subject, the king of right is to permit him upon his petition to use his name for the repeal of it, in scire facias at the king's suit.") (citing *The King v. Sir Oliver Butler*, 3 Lev. 220); *see* 3 William Blackstone, *Commentaries on the Law of England*, 261 ("[I]f the grant be injurious to a subject, the king is bound of right to permit him (upon his petition) to use his royal name for repealing the patent in a *scire facias*."). As one commentator explained:

> A void or illegal patent for an invention, is in law prejudicial to every one of her Majesty's subjects, for it commands them to abstain from the use of the art or invention comprised in it. For this reason every person is presumed to have such an interest in a patent for an invention, that if he alleges that it is illegal or void, he is entitled as of right to a *scire facias* in the name of the Queen, in order to repeal it.

William M. Hindmarch, *A Treatise on the Law Relative to Patent Privileges for the Sole Use of Inventions*, 385 (1847).

This broad-based standing to petition the King to revoke a patent contrasts sharply with the much more narrowly tailored standing requirement for seeking declaratory relief which, as discussed above, is closely cabined by the "case of actual controversy" requirement. Thus, unlike the practice of

petitioning for writ of *scire facias*, "[a] person not under reasonable apprehension of suit cannot overcome the absence of declaratory standing simply by challenging the patent prosecution and asserting fraud." *Medimmune, Inc. v. Genentech, Inc.*, 427 F.3d 958, 968 (Fed. Cir. 2005). Rather, a person with only a generalized complaint about an issued patent may proceed only by petitioning the government—either through the Patent & Trademark Office or the Justice Department as described above.

This distinction supports the determination reached by the Federal Circuit in *Technology Licensing* and *Lockwood* that a declaratory judgment action is more analogous to an "inverted" infringement suit than it is to the writ of *scire facias*. A declaratory judgment action settles a concrete and immediate dispute over a patent, including validity, infringement and the relief owed the patentee. If the potential defendant sues first, the patentee normally counterclaims for infringement and seeks relief, often as a compulsory counterclaim under FED. R. CIV. P. 13(a).[6] If the patentee files first, the defendant may counterclaim for invalidity in addition to asserting it as an affirmative defense. In either event, the case proceeds to trial as a private, civil patent infringement suit with invalidity asserted as a defense.

The Federal Circuit's conclusion that the right to jury trial is properly judged based on the nature of the underlying

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[6] If, in contrast, the patentee states that he does not intend to seek relief for infringement, the declaratory judgment action must be dismissed for lack of jurisdiction. *See, e.g., Super Sack Mfg. Corp. v. Chase Packaging Corp.*, 57 F.3d 1054, 1058-59 (Fed. Cir. 1995).

patent infringement dispute—including most importantly the nature of the relief sought—is therefore manifestly correct.[7]

D. The Procedural Posture of This Case Makes it Especially Inappropriate for Review.

Finally, the procedural posture of this case makes it an especially weak candidate for *certiorari* because the district court has already completed the evidence-taking phase of the bench trial Petitioner sought to avoid in its petition for mandamus to the Federal Circuit. The district court determined that it would be judicially efficient to proceed with the 11-week consolidated Second Wave trial with Petitioner included as one of the defendants. That decision can scarcely be questioned in view of the logistical difficulties of trying multiple defendants in a complex patent case in which the patents have a relatively short remaining life.

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[7] This conclusion comports with other important doctrines relating to declaratory judgments. For example, federal question jurisdiction over a declaratory judgment action is determined based upon whether the cause of action threatened by the declaratory judgment defendant "aris[es] under the Constitution, laws or treaties of the United States." 28 U.S.C. §1331; *Franchise Tax Bd. of Cal. v. Constr. Laborers Vacation Trust*, 463 U.S. 1, 18-19 & n.19 (1983) ("federal courts have consistently adjudicated suits by alleged patent infringers to declare a patent invalid, on the theory that an infringement suit by the declaratory judgment defendant would raise a federal question over which the federal courts have exclusive jurisdiction"). Also, whether the path of appeal in a declaratory judgment action leads to the Federal Circuit under 28 U.S.C. §1295 or to the regional Courts of Appeal under 28 U.S.C. §1291 also depends upon the nature of the underlying action intended to be addressed by the declaratory judgment. *Golan v. Pingel Enterprise, Inc.*, 310 F.3d 1360, 1366-67 (Fed. Cir. 2002); *Kidde, Inc. v. E. F. Bavis & Assocs., Inc.*, 735 F.2d 1085 (8th Cir. 1984).

Petitioner sought mandamus from the Federal Circuit only weeks before the scheduled commencement of trial but did not request expedited relief. Following denial of its mandamus petition, Petitioner did file an "emergency" motion to stay the trial under FED. R. APP. P. 8 coincidentally with its petitions for rehearing and rehearing *en banc*, all of which were denied. Petitioner thereafter did not seek any form of extraordinary relief in this Court.

Petitioner continues to vigorously assert that Respondents' patents are invalid and not infringed. The district court's findings of fact and conclusions of law pursuant to FED. R. CIV. P. 52(a) are expected to issue in due course. Appeal to the Federal Circuit by one or more dissatisfied parties is virtually certain. If Petitioner were to prevail in the resulting final decision from the Court of Appeals, Petitioner's right to a jury trial would no longer be a "live" issue and therefore would be moot. *Murphy v. Hunt*, 455 U.S. 478, 481 (1982) ("In general a case becomes moot 'when the issues presented are no longer 'live'' ... .") (quoting *United States Parole Comm'n v. Geraghty*, 445 U.S. 388, 396 (1980), which quoted *Powell v. McCormack*, 395 U.S. 486, 496 (1969)). Moreover, this is not the type of situation where the question presented is "capable of repetition yet evading review." *Murphy*, 455 U.S. at 482. In more "ordinary" patent infringement cases, the district court is more likely to stay trial until the higher courts can sort out the jury trial issue on a petition for mandamus. *See, e.g., Beacon Theatres, Inc. v. Westover*, 359 U.S. 500 (1959) (deciding Seventh Amendment question in mandamus proceeding).

The Court is therefore unlikely to encounter similar situations where the bench trial sought to be avoided, following denial of a petition for mandamus by the Court of Appeals, has already occurred. Now that the evidentiary

record has been closed in this case and the orderly decision-making process of the lower courts is underway, the Court should give that process the opportunity to play itself out rather than step in now and disrupt that process.

CONCLUSION

For the foregoing reasons, the petition should be denied.

Respectfully submitted,

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